

REMARKS

Reconsideration is respectfully requested.

The Examiner has noted that informal drawings were filed which are suitable for examination purposes. Applicant will submit formal drawings upon receipt of a notice of allowance.

The Examiner's comments and the cited references have been carefully considered, and, responsive thereto, applicant has amended Claims 1 and 16, has written new independent claims 25 and 26, and has rewritten allowable original Claims 9 and 17 in independent form as independent amended Claims 9 and 17.

A check in the amount of **\$80.00** for the additional independent claims is attached. Note that four independent claims have been added, but of the originally filed claims, two independent claims and four total claims are now not being considered due to the restriction requirement. Therefore the applicant has included a check fee to cover two independent claims beyond what was originally paid for. In the event the Examiner withdraws the restriction requirement, please deduct any additional claim examination fees from our Deposit Account No. 50-1887.

The Examiner rejected Claims 1-5, 8, 11-12, 14-16, and 19-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Adams in view of Foutch et al. The Examiner has stated that Adams shows substantially all the elements of applicant's Claims 1 and 16. Applicant respectfully submits, however, that, in addition to Adams not comprising a rattle, Adams further neither teaches nor suggests Applicant's holding means nor Applicant's attachment means. The Examiner has stated that the Adams eye 7 shows applicant's attachment means. However, the applicant's attachment means is substantially rigidly held in relationship to applicant's elongated body portion. The Adams reference however clearly shows in FIGS. 1, 6 and 7 that the Adams item 7 is part of the spindle 5 which is coupled via eye 6 to perforation 4, and the spindle 5 is free to flex and move in relationship to the Adams body portion 1. In contrast, applicant's attachment means 84, and 37 are rigidly held proximate to the hole 42 and 90 and thus the attachment means 84 and 37 may not flex and move in relationship to the body portion 21 of applicant's claimed invention. Therefore, applicant respectfully submits again that the Adams reference neither teaches nor suggests Applicant's rigidly held attachment means. Additionally, Applicant has amended Independent Claims 1 and 16 to even more clearly make this difference apparent.

Additionally, the Examiner claimed that the Adams holding means 21 shows applicant's holding means. Applicant respectfully submits, however, that the Adams screw 21 is not a holding means or holder for the rattle. Rather, the Adams screw 21 is for holding the feelers 25 (see Adams page 2, left hand column, lines 7-10.) Thus, applicant respectfully submits that the Adams reference neither teaches nor suggests applicant's holding means for a rattle and moreover certainly does not teach or suggest a holding means for a transverse rattle.

In order to make this lack of teaching more apparent, applicant has amended Claims 1 and 16 to more clearly label the holding means as a rattle holding means. Therefore, applicant respectfully submits that the Adams reference neither teaches nor suggests all the elements of applicant's claimed invention, requests the withdrawal of the Examiner's rejections and respectfully submits that claims 1-5, 8, 11-12, 14-16, and 19-20 are in condition for allowance.

The Examiner has also stated that the Foutch reference shows a rattle means. However, applicant respectfully submits that the Foutch reference does not show a transversely mounted rattle means attached to the body of the lure. Moreover, as previously mentioned in relationship to Adams, Foutch does not show a holding means for holding a rattle in a transverse position. These features are important because, as discussed in applicant's specification, it is desirous that a rattle be attached to the body of the lure in order to maximize the sound transmission of the rattle into the water (see specification Page 12, lines 14-17.) The Foutch reference, however, shows that the Foutch rattle is mounted parallel to the axis of the body of the lure and does not have the benefit of a spoon lure to transmit sound into the water nor the benefit of being in line with the normal side-to-side motion of the lure to produce more rattle. Thus the Foutch rattle will have a lesser amount of sound generated and transmitted into the water than will occur in Applicant's claimed invention.

Moreover, Foutch specifically teaches that the Foutch longitudinal rattle is "adapted to be mounted on fishing lures of the type comprising a body having a hook depending therefrom, and a band extending around the body" (Foutch Col. 1, lines 17-20.) Therefore, Foutch neither teaches nor suggests the desirability of mounting its rattle on applicant's claimed invention, a spoon type lure. Furthermore, Foutch actually teaches away from such a modification by virtue of stating that the Foutch type of lure is a jig lure that the Foutch rattle is designed for. As the Federal Circuit has stated, "a teaching away must be taken into account in the determination of obviousness". See *In re Gurley*, 31 USPQ 2d

1130, 1131 (Fed. Cir. 1994). Additionally, nowhere does Foutch suggest the desirability to experiment or adapt its axial rattle to become a transversely mounted spoon rattle.

It is noted that additional differences between the applicant's claimed invention and the Foutch reference include that the Foutch rattle is secured to the lure with a resilient band, i.e. A rubber band (see Foutch Col. 1, line 67.) A rubber band will damp rather than enhance any sound transmission. Also, the only sounding member of the Foutch reference is the small hook, whereas in contrast, the applicant's claimed invention comprises a comparatively large spoon to enhance sound transmission into the water. It is again expressly noted that the Foutch reference device is a jig lure (see Foutch Col. 1, line 65) as opposed to the spoon lure of applicant's claimed invention.

These differences between the Adams and Foutch references compared to the applicant's claimed invention are important because it is well settled that to support an obviousness rejection, the prior art must contain some teaching or suggestion to make the modifications suggested by the Examiner. In this regard the Federal Circuit has stated that "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.) Applicant respectfully submits that no such suggestion exists in either the Adams or the Foutch references to so modify or combine their elements to result in the applicant's claimed invention; moreover, Foutch specifically discusses placing a rattle on a jig, but not a spoon. Furthermore, in order to more particularly define the claimed invention, Applicant has added new Claims 25 and 26 to more particularly point out specific features of applicant's claimed invention, i.e. - the holding means is a rattle holding means for holding the rattle in a transverse position, and the combination of the rattle holding means and the attachment means substantially rigidly held proximate to the hole.

Applicant further respectfully points out that the Examiner has stated that the Foutch reference shows the elements of applicant's Claim 2. Applicant, however, respectfully points out that the Item 34 of the Foutch reference that the Examiner identified as said curved portion of said holding means of applicant's claimed invention is not part of any holding means comprising "said curved portion being structured and arranged to partially encircle said rattle means." Rather, the Foutch item identified is in fact the Foutch device rattle itself. Moreover, Foutch indeed possess no curved holding means. In order to more particularly define the claimed invention, applicant has amended

Claim 1 to more particularly point out specific features of applicant's claimed invention, i.e. - the holding means is a rattle holding means. Therefore, Applicant respectfully submits that the Examiner's rejection in this regard is improper.

The Examiner has also stated that the Adams reference shows applicant's elongated wire 5, having a looped second end 6. Applicant respectfully submits however that the applicant's Claims 11 and 19 actually state that the looped second end is "structured and arranged for attachment to said concave inner surface of said body portion." Furthermore, the elongated wire further defines the attachment means of Claims 1 and 16. The attachment means of these claims is rigidly held at the concave inner surface of the body portion - whereas in contrast, the elongated wire 5 of the Adams reference is flexibly connected at the leading edge of the Adams lure. Additionally, it is again noted that the independent claims 1 and 16 have been amended to specify that the "attachment means is substantially rigidly held proximate to said hole."

The Examiner has also stated that even though Adams does not disclose the location of a hole at a location 12% between the leading edge and the rounded trailing edge, that it would have been obvious to so locate since routine experimentation would be used to determine the optimum location of the hole. Applicant respectfully reminds the Examiner however, that a reference must contain some suggestion to combine features or perform experiments. The applicant's specification specifically states that the 12% location was chosen because "it has been found that this location of the rod hole provides for greater lift at the rounded leading edge thereby allowing the fishing lure to ride on the water's surface more efficiently at slow retrieval speeds." (page 11. lines 9-12) Therefore, while the applicant has specified why the 12% location was chosen, neither the Examiner nor the cited references have stated any reason or objective for an optimum location of a hole. In engineering it is known by those skilled in the art that when told to "optimize a system" they must be told what to optimize for! Neither the Examiner nor the references state that a goal of a hole location is to optimize the lure's surface performance.

Therefore, applicant respectfully submits that the above comments has overcome the Examiner's rejections and therefore respectfully requests the Examiner to withdraw such rejections and allow Claims 1-5, 8, 11-12, 14-16, and 19-20.

The Examiner has also rejected Claims 6-7 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Adam and Foutch et al. as applied to Claim 1 and further in view of Schavey. The Examiner has stated that Schavey shows a lure having a holder for

skirt 20 having a plurality of filaments that act as a weed guard. Applicant respectfully submits however that applicant's claimed invention comprises filaments wherein "said filaments substantially span a distance between said concave inner surface and said hook first end." In contrast, the filaments of Schavey do not span the distance between the concave inner surface and the said hook, but in fact extend past the hook by approximately the same distance as between the hook and the origin of the Schavey filaments. It is respectfully submitted that the use of the word "span" carries a definition meaning the distance or interval between two points. (See Webster's unabridged dictionary - 1913 edition.) i.e. The distance does not, and cannot, extend substantially past either of the two points. The span limitation does not mean "at least between" but states that the distance between the two points is spanned. The two points herein have been defined and claimed as the concave inner surface and the hook. And again, in contrast, the filaments of the Schavey reference device do not meet the claimed limitation of spanning the distance "between said concave inner surface and said hook first end."

Additionally, the Examiner has stated that Schavey also shows a propeller B having "a pair of circular propeller portions..." Applicant respectfully submits however that the Schavey propeller is not in fact the same as applicant's claimed propeller. Schavey discloses a specific propeller wherein "The wing 17 is shorter than the wing 16 and wing 16 is of substantially spiral shape" (See Schavey Page 1, Column 2, lines 32-34 and FIGS. 6 and 7.) In contrast, applicant's claimed invention features "a pair of substantially circular propeller portions" as specified in Claim 7. Applicant respectfully submits that not only does Schavey neither teach nor suggest a pair of substantially circular propeller portions, but in fact, Schavey teaches away from such construction specifying a non-pair set of propeller wings wherein wing 17 is shorter than the wing 16 and wing 16 is of substantially spiral shape. Therefore, applicant respectfully submits that to provide the lure of Adam with the propeller of Schavey is not merely one propeller being substituted for another as both the Schavey reference propeller and applicant's claimed propeller specifically comprise very different features. And therefore, Adams, Foutch and Schavey neither teach nor suggest providing the Adams lure as modified by Foutch with the Schavey propeller, nor more specifically, the claimed propeller of applicant's claimed invention.

Therefore, applicant respectfully submits that the above comments have overcome the Examiner's rejections and therefore respectfully requests the Examiner to withdraw such rejections and allow Claims 6-7 and 13.

In conclusion, for the reasons given above, and after careful review of the cited references, applicant respectfully submits that the cited references neither anticipate, teach nor suggest applicant's claimed invention. Applicant thus respectfully requests that the Examiner's rejections be withdrawn and all of the rejected Claims 1-8, 11-16, and 19-20, as amended, in addition to the previously allowed if re-written Claims 9-10 and 17-18, be allowed and sent to issue.


Applicant also respectfully requests (not as a matter of form but as a special request in this case) that the Examiner, after having an opportunity to review this paper, grant a telephonic interview to applicant's undersigned attorney to attempt to place this application in condition for allowance. Applicant's attorney will contact the Examiner to collaborate on scheduling an appropriate time.

Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to allow this application.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 50-1887.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on July 16, 2001.

Name of applicant, assignee, or
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Date of Sig. 07/16/2001
Signature: _____